

Appl. No.: 09/750,144
Amdt. dated 01/13/2006
Reply to Official Action of October 14, 2005

REMARKS/ARGUMENTS

This Reply is being filed in response to the final Official Action of October 14, 2005. The final Official Action rejects Claims 1-3, 5, 7, 10-13, 15, 17, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0049737 to Simon Hunt et al., in view of U.S. Patent No. 6,003,033 to Amano et al. The final Official Action also rejects Claims 4, 6, 8, 9, 14, 16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over the Simon Hunt publication in view of the Amano patent, and further in view of U.S. Patent Application Publication No. 2002/0143521 to Call. As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from the Simon Hunt publication, Amano patent and Call publication, taken individually or in combination, and accordingly traverses the rejections of the claims as being unpatentable over various combinations thereof. In view of the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application. Alternatively, as the remarks presented herein do not raise any new issues or introduce any new matter, Applicant respectfully requests entry of this correspondence for purposes of narrowing the issues upon appeal.

As background, the present patent application is directed to a compact tree representation of a document written in a markup language (e.g., XML). More particularly, independent Claim 1 provides a method of representing a document written in a markup language on a mobile terminal, and independent Claim 10 provides a mobile phone including software components for carrying out such a method. As recited, the method includes providing a virtual node tree describing the structure of the data types in the document but not containing actual document data, where each of the nodes in the virtual node tree respectively correspond to one element of a specific data type in the document. The method also includes providing a data array for each one of the nodes in the virtual node tree, where the data array includes information identifying the relationship of the node to other nodes in the virtual node tree and a reference indicating the location of data corresponding to the node. Thus, the data corresponding to the nodes using the reference included in the data array can be obtained by a set of software components in the mobile terminal.

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The final Official Action alleges that the Simon Hunt publication discloses all of the elements of independent Claims 1 and 10 including providing a virtual node tree and obtaining data corresponding to the nodes of the tree, but does not disclose a virtual node tree not containing actual document data. For that element, the final Official Action cites the Amano patent. The final Official Action then alleges it would be obvious to one skilled in the art to modify the teachings of the Simon Hunt publication with those of the Amano patent to include a virtual node tree that does not include actual document data.

A. Simon Hunt Cited Disclosure is not Prior Art to the Claimed Invention

With respect to the Simon Hunt publication, Applicant notes that the disclosure relied upon by the Official Action for disclosing elements of the claimed invention is not prior art to the present application, and can therefore not be properly cited against the claimed invention. In this regard, the Simon Hunt publication has a filing date of October 25, 2002 and claims priority as a continuation-in-part of two utility patent applications both filed April 25, 2001, as well as a provisional patent application filed April 26, 2000. The present application, on the other hand, has a filing date of December 29, 2000. The present application therefore has an effective filing date before the filing date of the Simon Hunt publication on October 25, 2002, and the two utility patent applications on April 25, 2001. Accordingly, the Simon Hunt publication is only prior art for the subject matter that was first disclosed by the Simon Hunt provisional application. By way of example, the content of the Simon Hunt provisional application that is carried over into the Simon Hunt publication may be considered prior art. Subject matter that is newly added in the Simon Hunt publication or utility applications that was not disclosed by the Simon Hunt provisional application is not prior art relative to the present application.

In order to determine the relevance of the Simon Hunt publication to the claimed invention, Applicant's undersigned attorney has obtained and reviewed a copy of the Simon Hunt provisional application from the USPTO's public PAIR Web portal. The final Official Action cited portions (e.g., paragraphs 0146-0151) of the Simon Hunt publication directed to a QDOM module generating a representation of a document object model (DOM) tree of a document into an array that includes the start and stop position of the document text as

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corresponding to the claimed feature of providing a virtual node tree. The Simon Hunt provisional application, however, is silent as to the QDOM or its technique for generating a representation of a DOM tree. The Simon Hunt publication does disclose normalizing a DOM tree, but the disclosed normalization does not realize a data array including information identifying the relationship of a node to other nodes in the virtual node tree and a reference indicating the location of data corresponding to the node, as in the claimed invention. Thus, at least those portions of the Simon Hunt publication that were relied upon by the Official Action are not prior art relative to the claimed invention.

B. No Motivation to Combine Simon Hunt and Amano

Moreover, Applicant notes that even if one could interpret (albeit incorrectly) the Simon Hunt publication to disclose elements of the claimed invention and to also be prior art to the claimed invention as alleged in the final Official Action, one skilled in the art would not have been motivated to combine the teachings of the Simon Hunt publication and Amano patent to teach or suggest the claimed invention. The final Official Action appears to be applying impermissible hindsight in finding motivation to combine the various cited references to disclose the claimed invention. *See In Re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (explaining that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure of a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight”).

As stated in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)) (emphasis added). In addition, as has been held by the Board of Patent Appeals and Interferences, and noted in the MPEP, the mere fact that one skilled in the art could adapt the reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art or the general knowledge of one skilled in the art must also provide a motivation or reason for one skilled in the art, without the benefit of applicant’s specification, to make the necessary modifications to the reference device. MPEP 2144.04(VI)(C.) (citing *Ex*

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parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Thus, Applicant respectfully submits that merely asserting that modifying the Simon Hunt publication with the Amano patent provides for easily describing a tree, and generating a data structure that corresponds to the tree in memory with the resultant description, without explaining the motivation or suggestion for such a combination (without relying upon hindsight or otherwise being guided by the present application), does not by itself render obvious the claimed invention.

Applicant further respectfully submits that the Call publication does not cure the defects of the Simon Hunt publication and Amano patent, and that the independent Claims 1 and 10, and by dependency Claims 2-9 and 11-21, are therefore patentable distinct from the Simon Hunt publication, Amano patent and Call publication, taken individually or in combination. Accordingly, Applicant also respectfully submits that the rejections of Claims 1-21 as being unpatentable over various combinations of the Simon Hunt publication, Amano patent and Call publication are overcome.

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CONCLUSION

In view of the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Reply, and as such, Applicant alternatively respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

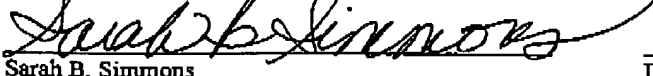


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January 13, 2006
Date